



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,672	08/06/2001	Larrie A. Deardurff	10010211-1	1525

7590 01/02/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,672

Applicant(s)

DEARDURFF ET AL.

Examiner

Betelhem - Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 21, 22 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. Applicant's response filed on 10/20/2003 has been fully considered. Claims 11-20, 23 and 24 are canceled, claim 26 is amended, and claims 1-10, 21, 22 and 25-29 are pending. (NOTE: Claims 1-10, 28 and 29 are still withdrawn as non-elected claims).
2. The claim objection has been withdrawn in view of Applicant's amendment, and the prior art rejection has been re-written as follow to include every element of the claimed invention.

Claim Rejections - 35 USC § 102

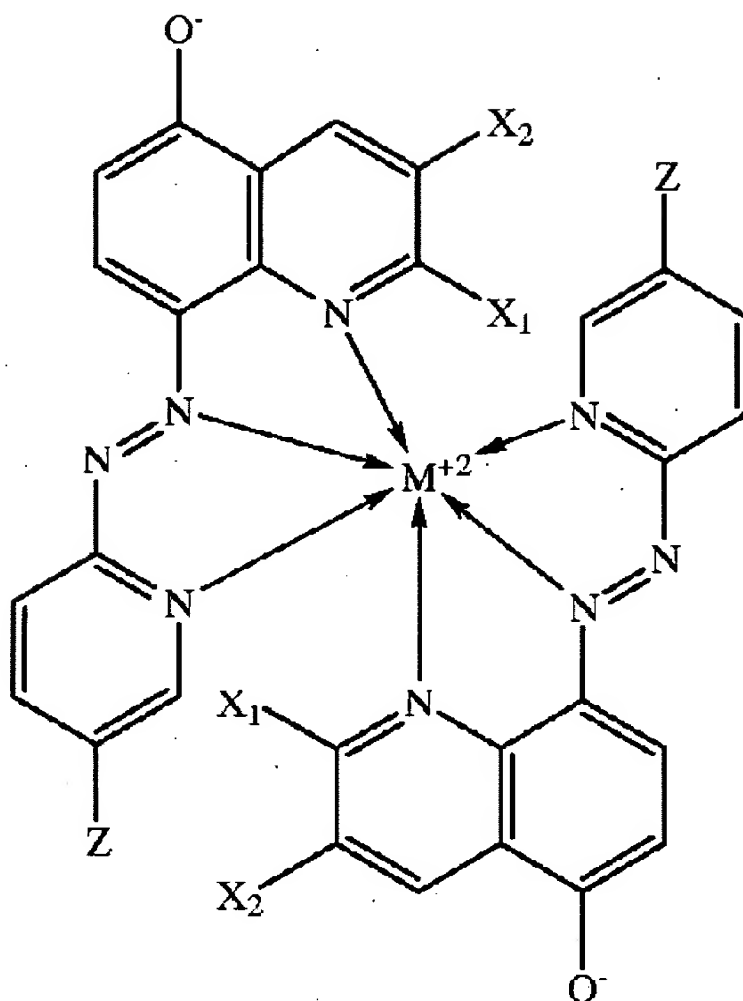
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

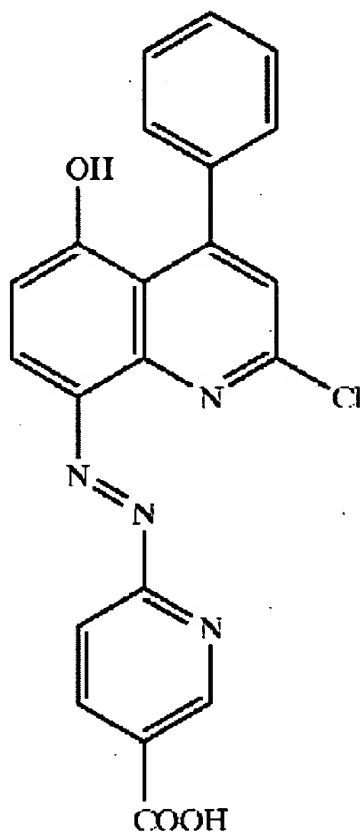
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21, 22, 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster et al. (US 5,997,622), as evidenced by Romano et al. (US 5,605,750).

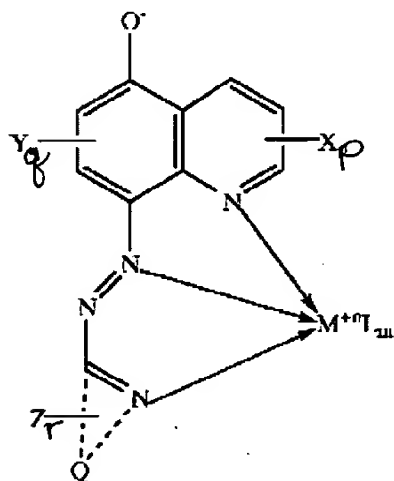
Webster discloses printing ink jet ink composition comprising nickel metal complex (col. 3, line 27) having a ligand on an ink receptive substrate (abstract). The ink composition has the following structure:



When Z is $COOH$ (col. 2, line 64); X_1 is chloro (col. 3, line 41); and X_2 is aryl group of 1-20 carbon atom (col. 2, line 67), the ligand has the following structure, which is equivalent to the claimed structure in claim 21.

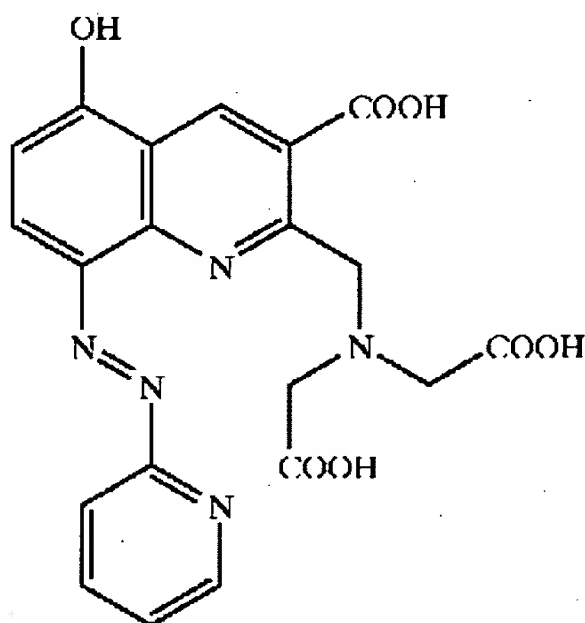


Weber discloses that the ink composition has the following **general** structure.



Art Unit: 1774

5. When p is 2; Xp¹ is COOH (col. 2, line 64); Xp² is carboxymethylamino (col. 4, line 22); Q is 5- or 6-membered hetrocyclic ring (col. 3, line 7); q is 0 (col. 3, line 12); and r is 0 (col. 3, line 10), the ligand has the following structure, which is equivalent to the claimed structure in claim 25.



When p is 2; Xp¹ is COOH (col. 2, line 64); Xp² is OH (col. 2, line 63); Q is 5- or 6-membered hetrocyclic ring (col. 3, line 7); q is 0 (col. 3, line 12); and r is 0 (col. 3, line 10), the ligand has the following structure, which is equivalent to the claimed structure in claim 27.

The ink composition further comprises pH adjuster (col. 10, line 53). The ink receptive substrate is porous (*see col. 11, line 10 of Weber and abstract of Romano*), which is evidenced by Romano.

Response to Arguments

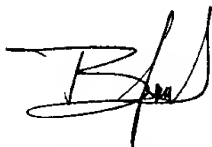
6. Applicant's arguments with respect to claims 21, 22 and 25-27 have been considered but are moot in view of the newly re-written prior art rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Betelhem Shewareged
December 23, 2003.